

**THIS OPINION WAS NOT WRITTEN FOR PUBLICATION**

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* GASTONE FIORI

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Appeal No. 96-2890  
Application 08/318,781<sup>1</sup>

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ON BRIEF

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Before MEISTER, ABRAMS and CRAWFORD, *Administrative Patent Judges*.

ABRAMS, *Administrative Patent Judge*.

**DECISION ON APPEAL**

This is an appeal from the decision of the examiner finally rejecting claims 11 and 22, which constitute all of the claims of record in the application, the other claims having been canceled.

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<sup>1</sup> Application for patent filed October 17, 1994. According to appellant, this application is a 371 continuation of International Application No. PCT/IT93/00076 filed July 20, 1993.

The appellant's invention is directed to a multi-layered board game. The subject matter before us on appeal is illustrated by reference to claim 11, which reads as follows:

11. A board game, comprising;  
a support structure;

three transparent game-boards joined with said support structure so as to be vertically separated from one another and such that an upper playing surface of each game-board defines a respective one of a first, second and third horizontal plane, wherein the external shape of the upper playing surface of each game board is defined by a multi-sided peripheral edge, and each of said game-boards having two sets of parallel paths with said sets being arranged orthogonal to each other on the playing surfaces with a plurality of the paths extending diagonally off from peripheral edges of the playing surface on which said paths are formed;

a first series of game pieces which first series includes a first, a second and a third game piece type with the three game piece types being different;

a second series of game pieces that is visually distinct from said first series and includes first, second and third game piece types which correspond with the first, second and third game piece types of said first series, and

wherein said support structure includes a column positioned centrally with respect to said first, second and third game boards, and wherein each of the game boards provides a similar sized playing field and each playing field has a similarly shaped peripheral shape.

#### **THE REFERENCES**

Appeal No. 96-2890  
Application 08/318,781

The references relied upon by the examiner to support the final rejection are:

Scott 4,883,278 Nov. 28, 1989

THREE-DIMENSIONAL CHESS, Time, February 4, 1952, page 15 (Time).

## THE REJECTIONS

Claims 11 and 22 stand rejected under 35 U.S.C. § 112, first paragraph, as being based upon a specification which fails to provide support for the invention as now claimed.<sup>2</sup>

Claims 11 and 22 also stand rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter which the appellant regards as the invention.<sup>2</sup>

Claims 11 and 22 further stand rejected under 35 U.S.C.  
§ 103 as being unpatentable over Scott in view of Time.

The rejections are explained in the Examiner's Answer and in Paper No. 8.

The opposing viewpoints of the appellant are set forth in the Brief and the Reply Brief.

<sup>2</sup> This is a new rejection made for the first time in the Examiner's Answer.

Appeal No. 96-2890  
Application 08/318,781

**OPINION**

*The Rejections Under 35 U.S.C. § 112*

It is the examiner's position in rejecting the claims under the first paragraph of 35 U.S.C. § 112 that no support is present in the specification for the expressions of "paths extending diagonally with respect to a peripheral edge of the playing surface" and "parallel lines extend diagonally off from a peripheral edge of a corresponding one of said game-boards." The examiner also questions the meaning of "diagonally off," which edge of the game-board is being referenced, whether there is a frame on the board of Figure 3, and whether Figure 3 corresponds to each board in Figure 1. See Answer, page 3.

Our study of the disclosure of the invention leads us to the conclusion that the examiner's objections are not well taken. From our perspective, one of ordinary skill in the art would have had no difficulty in understanding the construction of the three game boards, including the relationships of the various elements of the claims with respect to one another, which the examiner has questioned. We will not sustain the rejection under 35 U.S.C. § 112, first paragraph.

The rejection under the second paragraph of Section 112 is on the basis that the passages quoted above with regard to the

first paragraph rejection are vague and indefinite. We cannot agree, for the same reasons as were expressed immediately above. The rejection under 35 U.S.C. § 112, second paragraph, also is not sustained.<sup>3</sup>

*The Rejection Under 35 U.S.C. § 103*

The examiner's theory is that Scott discloses the claimed three stacked, transparent game boards but lacks the required two series of three different game pieces. For this, the examiner looks to Time, which discloses a three dimensional chess game in which there are two series of at least three different game pieces. The examiner's position apparently is that it would have been obvious to one of ordinary skill in the art to utilize the Time game pieces with the Scott stacked game boards. Essential to the examiner's conclusion is that the limitation that the paths of the game boards are diagonal to the peripheral edge of

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<sup>3</sup> We do note, however, some matters in the claims which are worthy of comment. We have interpreted the phrase "diagonally off from peripheral edges" in claim 11, and the similar phraseology which appears in claim 22, to mean that the paths diagonally intersect the peripheral edges. We also note two apparent errors in claim 11 which appear to be in need of correction: In line 25 of the claim as presented in the amendment accompanying the Reply Brief, it would appear that "playing field" should read --playing surface-- in both occurrences, and in line 26 that "peripheral shape" should read --peripheral edge--, in order to have proper antecedent basis.

Appeal No. 96-2890  
Application 08/318,781

the playing surfaces is "printed matter" which is "not limiting," and he has ignored it in setting out this rejection. See Paper No. 8, page 3.

We agree with the appellant that this position on the part of the examiner is in error, in that the claimed paths do not merely provide printed information, but are an integral part of the game board structure. The limitation is present in both claims, and it clearly is not taught by either of the applied references. Such being the case, a *prima facie* case of obviousness with regard to the subject matter of claims 11 and 22 has not been established, and we will not sustain the Section 103 rejection.

Appeal No. 96-2890  
Application 08/318,781

**SUMMARY**

None of the rejections are sustained.

The decision of the examiner is reversed.

**REVERSED**

JAMES M. MEISTER	)	
Administrative Patent Judge)	)	
	)	
	)	
NEAL E. ABRAMS	)	BOARD OF PATENT
Administrative Patent Judge)	)	APPEALS AND
	)	INTERFERENCES
	)	
MURRIEL E. CRAWFORD	)	
Administrative Patent Judge)	)	



Appeal No. 96-2890  
Application 08/318,781

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